

Claim Rejections Under 35 U.S.C. § 103

Claims 1, 2, 4, 5, 8, 11, 15, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Reilly (U.S. Patent Number 5,740,549), in view of Goetz (U.S. Patent Number 6,421,650) in view of Kolls (U.S. Patent No. 6,601,037).

Claim 1

Prima facie case of obviousness not established--Through the decisions of the CCPA and the Court of Appeals for the Federal Circuit, certain well-established principles of claim construction and review have been developed. If these principles are not met, a prima facie case of obviousness under 35 U.S.C. § 103 has not been established and the claim in issue should be allowed. The undersigned respectfully suggests that these tests are not met by the prior art in this case and a prima facie case of obviousness has not been established. These tests will be briefly applied to the individual claims rejected by the proposed combination.

There must be basis for the combination--The references themselves must suggest the combination proposed in the Office Action. Nothing in either the Reilly or Kolls references discusses or contemplates the inclusion of their invention on to a hand-held device. Simply because computing systems are involved in Reilly, Kolls, and Goetz does not mean that the transfer between Reilly and Kolls and Goetz is contemplated. The capabilities of hand-held devices, particularly in January 2000 (the priority date of the present application), were considerably limited in comparison to the computers described in Reilly and Kolls. Hand-held computers would simply not have been contemplated for the tasks described in Kolls and Reilly.

Also, the hand-held device of Goetz requires the use of a “smart card” to transfer information, because hand-held devices were not capable of receiving the amount of information that would have been transferred via the Reilly system. Therefore, there is no suggestion in any of the references of the combination proposed in the Office Action.

References are not properly combinable if their intended function is destroyed--A proposed combination of references under 35 U.S.C. § 103 is improper if the proposed combination would destroy the intended function of the references. The description given in the Reilly reference could not be handled by a hand-held device during the relevant time periods. The information transfer is too complex and voluminous for a hand-held device of the time to be able function properly. Since the proposed combination destroys the intended function, the combination cannot be properly made and a prima facie case of obviousness has not been made out.

All claim limitations must be considered--35 U.S.C. § 103 requires that the subject matter as a whole be reviewed. There are certain limitations of claim 1 which are still not shown in the combination proposed by the Examiner. For example, the combination of a hand-held device that allows prescription writing, as well as permanently stored advertising information is not disclosed in the cited references. According to 35 U.S.C. § 103, it must be considered and given proper weight if the correct result is to be reached.

The arguments presented with respect to claim 1 are relevant to claims 2, 4, 5, 8, 11, 15,

and 19, and are hereby incorporated by reference.

Claims 7, 12, 16, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Reilly (U.S. Patent Number 5,740,549), in view of Goetz (U.S. Patent Number 6,421,650) in view of Kolls (U.S. Patent No. 6,601,037) and in view of Lupi (U.S. Patent Number 5,755,462).

Claim 7

Obviousness to try and modification or combination of references is not the standard--The Examiner is not only combining references but he is also modifying them without any support for doing so. With reference to the Goetz reference, the Examiner states, that Goetz discloses printing the prescription information. However, in col. 6, lines 8-15 of Goetz, there is no mention of printing anything. That section of Goetz merely refers to the transfer of information via the “smart card.” A prima facie case of obviousness is not made out when two references are improperly combined and then modified further to meet the limitations of the claim in issue.


The arguments made with respect to claim 1 are relevant to claims 7, 12, 16, and 18, and are incorporated herein by reference.

CONCLUSION

Applicant now believes that this amendment complies with 37 CFR § 1.121 and thus requests examination of this Amendment. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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